

REMARKS

Claim 59 has been amended, Claims 1-24, 35-36, and 43-57 have been previously canceled, Claims 25-34 and 37-42 are withdrawn, and new Claims 62-67 have been added herewith. Claims 58-67 are pending in the present application.

Office Action of November 25, 2005

Applicant has carefully reviewed and considered the Office Action of November 29, 2005. Applicant hereby requests entry of this Amendment and further consideration of the present application in view of the following remarks.

In the Office Action, Claims 25-34 and 37-42 were unilaterally withdrawn from consideration as directed to a non-elected invention. The Office Action rejected Claims 59-61 under 35 U.S.C. §112 as failing to comply with the written description requirement. Claims 58-61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Banyai (U.S. Patent Number 6,702,668) in view of Heidel et al. (U.S. Patent Number 5,342,047). Applicant respectfully traverses these grounds of rejection and requests reconsideration thereof in view of the above amendments and the following remarks.

Restriction Requirement

The Office Action withdrew Claims 25-34 and 37-42 from consideration as directed to a non-elected invention. The Office Action stated that the amended of Claim 25 in the previous amendment and response changed the claimed game. Specifically, the Office Action stated that in the unamended claims, the game is concerned with replacing matching indicia, such as wildcards, whereas the amended claims are instead drawn to a random multiplier game. Applicant traverses this constructive election, but nonetheless, has withdrawn Claims 25-34 and 37-42 from consideration in order to facilitate prosecution of the present application.

Rejection under 35 U.S.C. §112

The Office Action rejected Claims 59-61 under 35 U.S.C. §112 as failing to comply with the written description requirement. Specifically, the Office Action stated that Claim 59, and Claims 60-61 as dependent thereupon, improperly introduced the

element of “the random multiplier being independent of an outcome of said game,” which is not supported in the specification and constitutes new matter. Applicant has amended claim 59 to remove this element, and therefore, Applicant submits that grounds for this rejection have been removed.

Rejection under 35 U.S.C. §103

Claims 58-61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Banyai (U.S. Patent Number 6,702,668) in view of Heidel et al. (U.S. Patent Number 5,342,047). The Office Action states that Banyai teaches the invention substantially as claimed, including a lottery controller with a processor and memory coupled to the lottery terminal, but does not teach printing tickets. The Office Action further asserts that Heidel teaches video lottery system that includes a ticket printer. The Office Action further states in regard to claim 59, that Banyai teaches that the controller is programmed to randomly associate the multiplier factor with said indicia of a second type. Applicant respectfully traverses these rejections and request reconsideration thereof.

Claim 58

Applicant firstly notes that in response to Applicant's arguments, in paragraph 8 of the Office Action, that it is stated that Applicant's argument “that Banyai fails to teach a lottery controller that is programmed to replace first indicia with second indicia” fails because “[t]his limitation is no longer in the claim.” Applicant traverses this assertion and points out that in claim 58, which is not currently amended, this element is presented in the same manner prior to the present Office Action.

Specifically, claim 58 continues to include the element of “said lottery controller being programmed to replace one or more of said indicia of a first type from said first plurality of indicia with an indicia of a second type.” While applicant specifically made the primary arguments in this regard in the last Response with respect to Claim 25, the arguments were also put forth in support of the patentability of amended Claim 58. See Page 13, Response under 37 C.F.R. §1.111(b) dated July 12, 2005. The Office

Action is therefore incorrect for deeming the element removed and ignoring Applicant's arguments relative to this element.

Applicant reiterates its position that nowhere is it disclosed in Banyai that the terminal controller is programmed to receive wager data, receives data representing a second indicia, replaces one or more indicia of a first type, and matches the indicia of the second type, as recited in Claim 58. Banyai simply does not disclose a lottery controller performing the functions listed in claim 58; in fact, it is clear from some of the passages that the actions taken by the lottery controller are done by a player in Banyai. One example of such teaching by Banyai is in a passage in Column 2, Lines 1-5, cited in an earlier Office Action as disclosing a controller programmed to replaced one or more indicia of a first type with an indicia of a second type (Page 3, second paragraph, Lines 11-14), yet the passage in Banyai states “when the wild designation is drawn the player may deem one of his assigned designations or number to have been drawn” (emphasis added). Furthermore, in Banyai, the “wild” symbol is part of generated by a game terminal as part of drawings (Col. 2, Lines 1-5; Col. 4, Lines 36-39; Col. 5, Lines 2-5, Col. 6, Lines 8-11) and when a wild symbol is drawn, it substitutes or represents a symbol either selected by or assigned to a player.

Conversely, the present invention discloses that a player-selected symbol (indicia of a first type) may be replaced by a randomly occurring symbol (indicia of a second type) (Specification, Page 22, Lines 16-17), as recited in Claim 58. In order to render obvious the present invention, a reference must teach or suggest all elements of the rejected claims, MPEP §2142. In view that Banyai and Heidel et al., either individually or in combination, do not disclose at least the element of a lottery controller replacing a user selected indicia of a first type at a lottery controller programmed to receive wager data, to receive data representing a second indicia, to replace one or more indicia of the first type, and to match the indicia of the second type, as recited in Claim 58. Accordingly, Applicant submits that Claim 58, is patentable over the combination of Banyai and Heidel et al., and allowance thereof is respectfully requested.

Claims 59-61

Claims 59-61 are dependent upon Claim 58, and therefore, likewise contain the element of a replacing a user selected symbol from a lottery controller programmed to receive wager data, to receive data representing a second indicia, to replace one or more indicia of a first type, and to match the indicia of the second type. Applicant therefore submits that Claims 59-61 are patentable over the combination of Banyai and Heidel et al., for the reasons stated above with respect to the patentability of Claim 58, and allowance thereof is respectfully requested.

New Claims 62-67

Applicant submits that new Claims 62-67 are directed to subject matter commensurate in scope to Claims 58-61, and therefore, new Claims 62-67 are patentable over the references for the reasons stated above with respect to the patentability of Claims 58-61, and allowance thereof is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that claims 58-67 are in condition for allowance and entry of the present amendment and notification to that effect is earnestly solicited. If necessary, the Examiner is invited to telephone Applicant's attorney (404-815-3380) to facilitate prosecution of this application.

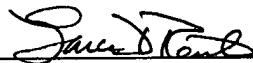
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No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested to Deposit Account No. 03-0683.

Respectfully submitted,

Stephen Penrice.
By his Representatives,

Carlton Fields, P.A.
1201 West Peachtree Street, Suite 3000
Atlanta, GA 30309-3450
Telephone: 404-815-3400
Fax: 404-815-3415

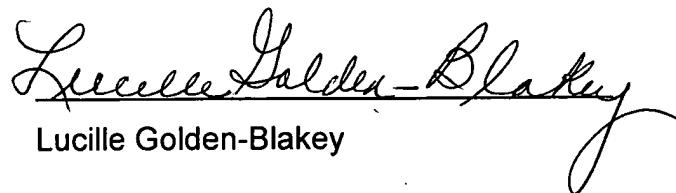


Lance D. Reich
Reg. No. 42,097

Date 15 May 2006

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, Alexandria, VA 22313-1450, on this 15th day of

May, 2006.



Lucille Golden-Blakey